

REMARKS/ARGUMENTS

The rejection of record is a double patenting rejection of the "same invention" type under 35 USC 101. According to the MPEP.II.A, a reliable test for double patenting under 35 USC 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. That is, is there an embodiment of the invention that falls within the scope of one claim but not the other.

In this case, the double patenting rejection is against co-pending application SN 09/950,568. It is respectfully submitted that, by the test noted above, the statutory double patenting rejection under 35 USC 101 should be withdrawn based on the present claims.

As can be seen from the Examples of the present application and as required in claim 1, the present invention includes, as a required feature, that the magnetic powder is coated with inorganic glass. The Examples show the presence of inorganic glass as part of the invention, as well.

Appl. No. 09/997,066
Reply to Office Action of July 21, 2003

The claims in SN 09/950,568 do not require the presence of inorganic glass. Therefore, a magnet which is formed of a magnetic powder dispersed in a resin, where there is an absence of inorganic glass in the composition, would not infringe the claims of the present application but would infringe the claims of SN 09/950,568. The two inventions are therefore not the "same."

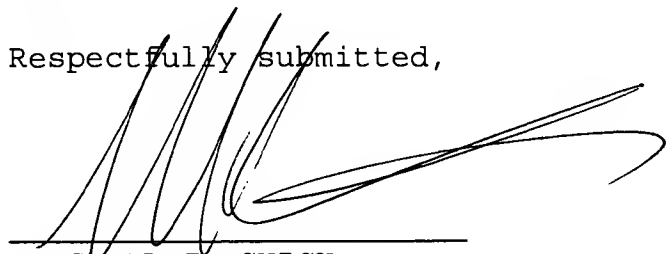
In view of the above, withdrawal of the rejection and allowance of the present application is respectfully requested.

In addition to the above, in order to more clearly the distinguish the present invention from the invention in 09/950,568, an AMENDMENT is being filed in 09/950,568 to exclude the presence of inorganic glass from the bonded magnetic composition.

Allowance of the application is therefore respectfully requested. If there are additional issues or questions, please call the below-named attorney for the possibility that resolution of such issues can be facilitated.

Frishauf, Holtz, Goodman
& Chick, P.C.
767 Third Ave., 25th Floor
New York, NY 10017-2023
Tel. No. (212) 319-4900
Fax No.: (212) 319-5101
MJC/ld

Respectfully submitted,


MARSHALL J. CHICK
Reg. No. 26,853